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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,874	01/14/2004	Gail Iannacone	23282-002	5191
21890	7590	01/05/2006	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,874

Applicant(s)

IANNACONE, GAIL

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 11-12, 19-20 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oatman 4,658,515 in view of Usui 6,264,681. Oatman '515 discloses all the limitations substantially as claimed including the following: a sole 5 comprising a lower sole 50, a flexible upper sole 50, and a plurality of unamalgamated beads 40 disposed between the upper sole and the lower sole; the beads are retained between the upper sole and the lower sole (see Figure 4); the beads always remain free to shift around in response to changes in pressure that occur during ordinary walking (see col. 2, lines 60-61); at least one strap 60 connected to the sole and configured to secure the sole to the bottom of a user's foot; the beads that are disposed between the upper sole and lower sole are enclosed in a thin and flexible inner bag 10, 20; the bag being disposed between the upper sole and the lower sole (see Figure 4); an upper 60 connected to the sole; lower sole 50 with upper surface (non-reflecting); sidewalls 34 having an inner surface; the sidewalls are connected to the lower sole so as to form a recess that is bounded by the inner surface of the sidewalls and the upper surface of the lower sole (see Figures 3 and 4); a plurality of unamalgamated small beads 40 disposed in the recess (defined by the sidewalls and upper surface of the lower sole); a thin flexible upper sole 50 disposed on top of the beads and arranged to retain the beads within the recess (see Figure 4); the beads remain free to shift with different applied pressures and the permeation of air from the immediate vicinity of the footwear into the bead is always unimpeded (see col. 2, lines 60-61); the recess occupies an area that is at least half as large as the area of the upper sole (see Figures 4, recess is divided into multiple recesses, but is, as a whole, almost as large as the upper sole); at

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least one part of the recess is at least one about one quarter inch deep (see Figures 3 and 4); the plurality of beads is at least ten thousand (relative size of beads to area covered would approximate this number). Oatman '515 does not specifically disclose the bag or portions holding the beads as being air-permeable. Usui '681 teaches that polyethylene, used as enclosing layers in a foot warming insole, is air permeable, which is important because gas permeability has great bearing upon the control of reaction rate of the exothermic composition and/or of exothermic temperature and therefore control of gas permeability is desired in order to obtain effective warming effect and to prevent any low temperature burn to safety. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the layers 20 and 10 of Oatman '515 out of air permeable polyethylene (already made of polyethylene, see col. 2, line 36-40) to allow for better control of heat and prevent low temperature burn as taught by Usui '681.

3. Claims 5-6, 9-10, 15-16 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied immediately above in view of Grim 5,392,534. The references as applied immediately above disclose all the limitations of the claims except for the beads being roughly spherical expanded thermoplastic (polystyrene) beads having an average diameter between $\frac{2}{3}$ and 1mm and the beads being at least ten thousand in number. Grim '534 teaches that, beads used in a sole of a shoe can be roughly spherical expanded thermoplastic beads (see col. 3, lines 11-14) with the beads being roughly spherical expanded polystyrene beads (see col. 3, lines 11-14) having an average diameter between two thirds mm (approximately $\frac{1}{38}$ inch) and one mm (approximately $\frac{1}{25}$ inch) (see col. 3, lines 42-46), the plurality of beads comprises at least ten thousand beads (size of beads with respect to size of shoe shown), this is to allow for closer conformity of the sole to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the beads of the references as applied immediately above out of spherical expanded thermoplastic with an average diameter between

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1/38 and 1/25 of an inch, as taught by Grim '534, to allow for closer conformity of the sole to the user's foot to aid in retaining the heat as close to the foot as possible to prevent heat loss to the surrounding area.

4. Claims 3, 7, 8, 13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 6, 11 and 16 above in view of either of Spence 3,449,844 or Nichols 6,061,928. The references as applied to claims 1, 6, 11 and 16 above disclose all the limitations substantially as claimed except for the sole being made of fabric. Nichols '928 and Spence '844 are examples of known soles in the art that are made of fabric to allow for a better feel between the sole and the user's foot as well as to protect the user's sole from being scratched during use of the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper sole of the references, as applied to claims 1, 6, 11 and 16 above, out of fabric to aid in protecting the user's foot sole from being uncomfortable and scratched from the contact of the user's foot with the sole.

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 11 above in view of Courian 4,843,736. The references as applied to claims 1 and 11 above disclose all the limitations substantially as claimed except for the upper sole being made of stretch jersey fabric. Courian '736 teaches that the material in a shoe that touches the user's foot can be made of stretch jersey fabric to make it feel softer against the user's skin and prevent irritation of the user's skin from use of the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper sole of the references as applied to claims 1 and 11 above out of stretch jersey fabric to give the user a better feel of the shoe against the user's foot and prevent irritation of the user's foot from wearing the shoe.

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Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
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